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| EXAMINER |
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LUGO, CARLOS

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| ART UNIT | PAPER NUMBER |
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3676

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,924

Applicant(s)

FURLONG, JONATHAN W.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, drawn to a door handle assembly, classified in class 292, subclass 336.3.
- II. Claims 10-17, drawn to a door, classified in class 292, subclass 348.
- III. Claims 18-20, drawn to a method of mounting a door handle assembly to a door, classified in class 292, subclass 352.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions in Group I and in Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not requires that the latch bolt is coupled to a handle and that the attachment member is movable between a first and a second position relative to the handle. The subcombination has separate utility such as a door handle assembly that could be mounted to a door that only has one aperture so as to dispose the latch bolt and the attachment member can be screwed directly to the door.

Inventions in Group I and in Group III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus, the door handle assembly, can be used to practice a different method of installation wherein the door has only one aperture that could receive the latch bolt and the attachment member can be screwed directly to the door.

Inventions in Group II and in Group III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus, the door handle assembly, can be used to practice a different method of installation wherein the attachment member can be screwed directly to the door.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, the search required for Group I is not required for Group III, and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Mr. Thomas Otterlee on February 24, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-9. Applicant in replying to this Office action must make affirmation of this

election. Claims 10-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the first and second positions of the attachment member, as claimed in claim 1, and the difference in distance, as claimed in claim 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and

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informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The specification is objected to because of the following informalities:

- Page 5 Line 19, change "attachment member" to -attachment-.

Appropriate correction is required.

Claim Objections

6. **Claim 6 is objected** to because of the following informalities:

- Claims 6 Line 1, change "claim 1, further comprising" to -claim 1, wherein the attachment member includes-

Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

- The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. **Claims 1-9 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 1 recites the limitation "a latch bolt couple to the handle" in line 4 and further recites, "the attachment member being movable relative to the handle" in lines 6 and 7.

However, it is unclear to which handle the applicant is referring to because, as seen in Figure 2, the applicant shows two handles, a first handle (50) and a second

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handle (55). The latch bolt (at 40) is coupled to the second handle (55), however, the attachment member (at 45) is movable relative to the first handle (50). The first handle (50) is not coupled to the latch bolt, a thumb actuator is the part coupled to the latch bolt.

Therefore, in order to continue with the examination, the limitation, that the latch bolt is coupled to the handle, will not be considered. Appropriate correction is required.

As to Claim 5, the claim recites the limitation "wherein the handle includes a slot and the attachment member includes a shoulder portion engageable with the slot". However, it is unclear what the applicant is claiming as his invention since the handle (50) does not have a slot that receives a shoulder portion of the attachment member. The attachment member is attached or engaged to the handle by means of bolt (145) that is screwed into a threaded bore (160) of the handle. As shown in the drawings, the attachment member includes a base (130) and a slider (135). The base includes a slot (170) and the slider includes a shoulder (195) that is received in the slot.

Therefore, in order to continue with the examination, the claim will be examined as "the attachment member is secured to the handle by a threaded connection". Appropriate correction is required

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. **Claims 1-5 are rejected** under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,084,940 to Loffler et al (Loffler).

Regarding claim 1, Loffler discloses a door handle assembly (Figure 1) attachable to a door comprising a handle (24) coupled to the door; a latch bolt (not shown but an ordinary skill in the art will know that the latch bolt is usually placed so as that allow the bolt to extends along a latch bolt axis between an extended position and a retracted position from a side of the door facing the doorjamb); and an attachment member (28) defining an attachment axis and movable relative to the handle (24) between a first position and a second position (Figures 1-8, Col. 4 Lines 33-42).

As to claim 2, Loffler illustrates that the first position is a first distance from the latch bolt axis and the second position is a second distance from the latch bolt axis, the first distance being different from the second distance (Figures 8-11).

As to claim 3, Loffler illustrates that the latch bolt axis is substantially perpendicular to the attachment axis (Figures 8-11).

As to claim 4, Loffler illustrates that the attachment member is movable along an adjustment axis, the adjustment axis being substantially perpendicular to the latch bolt axis (Figures 8-11).

As to claim 5, Loffler discloses that the attachment member (28) is secure to the handle (24) by a threaded connection (at 48).

11. Claims 1-4 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 4,006,927 to Recupero.

Regarding claim 1, Recupero discloses a door handle assembly (Figure 1) attachable to a door comprising a handle (9) coupled to the door; a latch bolt (not shown but an ordinary skill in the art will know that the latch bolt is usually placed so as that allow the bolt to extends along a latch bolt axis between an extended position and a retracted position from a side of the door facing the doorjamb); and an attachment member (at 7) defining an attachment axis and movable relative to the handle between a first position and a second position (depending of where the attachment member is placed with respect to the hand grip 6).

As to claim 2, Recupero discloses that the first position is a first distance from the latch bolt axis and the second position is a second distance from the latch bolt axis, the first distance being different from the second distance (depending of where the attachment member is placed with respect to the hand grip 6).

As to claim 3, Recupero discloses that the latch bolt axis is substantially perpendicular to the attachment axis.

As to claim 4, Recupero discloses that the attachment member is movable along an adjustment axis, the adjustment axis being substantially perpendicular to the latch bolt axis.

As to claim 6, Recupero discloses that the attachment member further comprises a base (7) attached to the handle (11) and defining a slot (wherein the grip 6 is disposed).

Allowable Subject Matter

12. **Claim 7 would be allowable** if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. Claims 8 and 9 would also be allowed because the claims depend from claim 7.

Reasons For Allowable Subject Matter

13. The following is an examiner's statement of reasons for allowable subject matter:

Claim 7 presents allowable subject matter over the prior art of record because the teachings of the references taken as a whole do not teach or render obvious the combination set forth, including that the attachment member includes a T-shaped slider slidably engageable with the slot of the base.

Recupero discloses a base member (7) with a slot, however, the slot is to receive the hand grip that is part of the latch housing, not to receive a T-shaped slider.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.


Carlos Lugo
AU 3676

February 24, 2005.



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600